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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/658,143	09/09/2003	Paul Lew	36-9540-6520-0000-5	5415
7590	01/25/2005		EXAMINER	
Dana Andrew Alden MacLean-Fogg Company 1000 Allanson Road Mundelein, IL 60060			LE, DAVID D	
			ART UNIT	PAPER NUMBER
			3681	

DATE MAILED: 01/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<i>PL</i> <b>Office Action Summary</b>	Application No.	Applicant(s)
	10/658,143	LEW ET AL.
	Examiner	Art Unit
	David D. Le	3681

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 23 August 2004.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 19 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 09 September 2003 is/are: a) accepted or b) objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All
  - b) Some \*
  - c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>12/21/04</u> .	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____

## **DETAILED ACTION**

### **Documents**

1. The following documents have been received and filed as part of the patent application:
  - Declaration, received on 09/09/03
  - Response, received on 08/23/04
  - Substitute Specification, received on 08/23/04
  - Change of Power Attorney, received on 08/23/04
  - Supplemental Response, received on 11/08/04
  - Substitute Specification, received on 11/08/04
  - Information Disclosure Statement, received on 12/21/04

### ***Information Disclosure Statement***

2. The information disclosure statement (IDS) submitted on 21 December has been fully considered. See the attached 1449 Form.

### ***Response to Supplemental Amendment***

3. The supplemental reply filed on 08 November 2004 was not entered because supplemental replies are not entered as a matter of right except as provided in 37 CFR 1.111(a)(2)(ii). The supplemental reply is not limited to the following:
  - a. Cancellation of claim(s);
  - b. Adoption of the examiner suggestion(s);
  - c. Placement of the application in condition for allowance;

- d. Reply to an Office requirement made after the first reply was filed;
- e. Correction of informalities (e.g., typographical errors); or
- f. Simplification of issues for appeal.

4. Substitute Specification filed 08 November 2004 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material, which is not supported by the original disclosure, is, for example, the *Curved member(s)* as supposed to the originally disclosed *ball bearing(s)*.

Accordingly, the Substitute Specification, filed on 08 November 2004, has not been entered.

***Response to Amendment***

5. This is the response to the amendment filed on 23 August 2004. Claim 19 is pending.

6. Substitute Specification filed 23 August 2004 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material, which is not supported by the original disclosure, is, for example, the *Curved member(s)* as supposed to the originally disclosed *ball bearing(s)*.

Accordingly, the Substitute Specification, filed on 23 August 2004, has not been entered.

***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claim 19 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 19 recites the limitation “a plurality of curved members”, which the present specification does not disclose or provide clear definitions to support the claimed “plurality of curved members”.

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. **Claim 19 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Claim 19:

Claim 19 recites the limitations “a forward section” and “an outwardly sloping surface extending from the forward section to the tapered section.” It is unclear what applicant is referring to by the phrases “a forward section” and “an outwardly sloping surface”.

***Claim Rejections - 35 USC § 102***

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. **Claim 19 is rejected under 35 U.S.C. 102(b) as being anticipated by U. S. Patent No. 3,432,016 to K. Vogt.**

Claim 19:

Vogt (Figs. 1-3; column 1, line 46 – column 3, line 7) discloses a magnetic roller clutch comprising:

- A first sleeve (1) and a second sleeve (8);
- Wherein the first sleeve includes an outer surface that includes a plurality of slots (4); said slots are provided with a forward section (Fig. 2, being the slot portion that element 5 is contacting), a tapered section (Fig. 1, being the slot portion that element 5 is contacting), and a outwardly sloping surface extending from the forward section to the tapered section (see Fig. 1 or 2);

- Wherein the second sleeve includes a wall that includes a plurality of steps (see Fig. 1 or 2); and a plurality of curved members (5); said curved members travel from the forward section along the outwardly sloping surface toward the tapered section, whereat the curved members contact the steps and transfer torque between the first sleeve and the second sleeve (Figs. 1 and 2).

***Conclusion***

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Shiozaki et al. (U. S. Patent No. 4,770,279) teaches a one-way clutch as shown in Figs. 1-2.
- Schulz et al. (U. S. Patent No. 4,059,028) teaches a multiple speed hub comprising a clutch as shown in Fig.2.
- Cha (U. S. Patent No. 5,125,489) teaches a high-torque dual-purpose hub assembly for a bicycle as shown in Figs. 3-4.
- Meier-Burkamp et al. (U. S. Patent No. 5,810,139) teaches a friction device for controlling a clamping roller coupling of a bicycle hub as shown in Fig. 2.
- Kirk (U. S. Patent No. 6,065,580) teaches a freewheel hub for bicycle as shown in Fig. 3.
- Chen (U. S. Patent No. 6,123,179) teaches a bicycle freewheel hub as shown in Fig. 3.
- Kanehisa et al. (U. S. Patent No. 6,523,659) teaches a bicycle hub as shown in Fig. 2.

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David D. Le whose telephone number is 703-305-3690 or 571-272-7095. The examiner can normally be reached on Mon-Fri (0700-1530).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles A Marmor can be reached on 703-308-0830 or 571-272-7095. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3681

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
ddl

*Charles A Marmor 1/19/05*  
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